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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/671,860  | 09/25/2003  | Koichi Ito           | 2487                | 8675             |
| 7617  | 7590        | 05/26/2005           | EXAMINER            |                  |
| BRUZGA & ASSOCIATES<br>11 BROADWAY, STE 400<br>NEW YORK, NY 10004 |             |                      | CHANG, VICTOR S     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1771                |                  |

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

|                                      |                                    |  |
|--------------------------------------|------------------------------------|--|
| <b>Application No.</b><br>10/671,860 | <b>Applicant(s)</b><br>ITO, KOICHI |  |
| <b>Examiner</b><br>Victor S. Chang   | <b>Art Unit</b><br>1771            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 11 April 2005.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-112 is/are pending in the application.  
4a) Of the above claim(s) 1-51, 58-77, 82-103, 109 and 112 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 52-57, 78-81, 104-108, 110 and 111 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/22/2003.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

RD

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group II (claims 52-101), and Species A, I and K in the reply filed on 4/11/2005 is acknowledged. The traversal is on the ground(s) that "no substantiated example has been presented that the claimed product can be made by co-extrusion" (Remarks, page 17, second full paragraph, last two lines). This is not found persuasive because the Examiner repeats that "these inventions are distinct and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper" (see Office action dated 2/9/2005, page 2, bottom paragraph). Further, the Examiner respectfully notes that Applicant fails to distinctly and specifically point out any supposed error regarding the alternative co-extrusion method in the restriction requirement, i.e., merely stating "no substantiated example" is insufficient to overcome the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. Additionally, in response to new claims 110-112 filed 4/11/2005, the Examiner notes that in a telephone conversation with Mr. Kenneth Dusyn on 5/9/2005, Species "water-based polyurethane paint" in claim 111 is elected, and claim 112 is also withdrawn as non-elected.

***Examiner's Amendment***

3. The Examiner has also telephoned Kenneth Dusyn on 5/23/2005 regarding method claim 109, Mr. Dusyn has agreed since claim 109 is a method claim depended upon non-elected method claims 1 or 28, claim 109 clearly belongs to non-elected Group I as well, and being withdrawn from consideration as well.

Finally, an examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kenneth Dusyn on 5/23/05.

In the preambles of claims 102-108, delete the phrase "method or".

Finally, in summary, the elected claims are: claims 52-57, 78-81, 104-108, 110 and 111.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 52-57, 78-81, 104-108, 110 and 111 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More particularly, in independent claim 52, the recitation, *inter alia*, "... said coating comprising (i) a primary layer comprising an aqueous solution ..." is considered as failing to comply with the enablement requirement, because the specification explicitly discloses that "The extent of drying should be substantially complete so as to avoid the formation of blisters or bubbles in the film layer after the polyurethane paint is applied to the primary layer." (specification, page 18, lines 9-12). As such, the specification clearly discloses that complete drying is necessary, and the recitation "a primary layer comprising an aqueous solution ..." in independent claim 52 is not enabled.

Similarly, in independent claim 78, the recitation, *inter alia*, "said film forming layer comprising an aqueous solution of ..." fails to comply with the enablement requirement, as set forth above. Appropriate clarification or correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 52-57, 78-81, 104-108, 110 and 111 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps are the drying step, as set forth above. Additionally, it should be noted that while claim 52 also recites "... said primary layer being capable, upon drying, of forming a ... continuous film ..." as a required property, this "capable"

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limitation is merely optional, i.e., not positively recited as a limitation of instant invention, as such it does not constitute a limitation in any patentable sense.

Similarly, in independent claim 78, the drying step is omitted, as set forth above. Appropriate clarification or correction is required.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making a coated polyurethane product.

DD 136589A is directed to a molded soft polyurethane foam. The foam inserts are coated with a plastics dispersion, pref. polyvinyl acetate or PVC latex or mixtures.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Victor S Chang  
Examiner  
Art Unit 1771

5/23/2005